



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/900,803 | 07/06/2001 | Brian Yen | 060497.000003 | 6824 |
| 70416 7590 02/15/2008 THELEN REID BROWN RAYSMAN & STEINER LLP 2225 EAST BAYSHORE ROAD SUITE 210 PALO ALTO, CA 94303 | | | | |
| EXAMINER | | | | |
| WORJLOH, JALATIE | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 3621 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 02/15/2008 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

1 UNITED STATES PATENT AND TRADEMARK OFFICE
2
3

4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

7 *Ex parte* BRIAN YEN
8
9

10 Appeal 2007-2826
11 Application 09/900,803
12 Technology Center 3600
13
14

15
16 Decided: February 15, 2008
17

18
19 Before WILLIAM F. PATE, III, ANTON W. FETTING, and
20 DAVID B. WALKER, *Administrative Patent Judges*.
21 FETTING, *Administrative Patent Judge*.

22
23
24 DECISION ON APPEAL
25
26

27 STATEMENT OF CASE

28 Brian Yen (Appellant) seeks review under 35 U.S.C. § 134 of a final rejection
29 of claims 1-42 and 44-81, the only claims pending in the application on appeal.

30 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).
31

1 We AFFIRM.

2 The Appellant invented a system for distributing data via a peer-to-peer (P2P)
3 network topography. The system is on a central server and includes a distribution
4 engine, which keeps a database of (1) files that are available over the network at
5 consumer boxes; (2) consumer boxes' addresses; and (3) consumer box owner data,
6 which may include name, address, and payment information, as well as other data.
7 Upon receiving a request for a data file from a consumer box, the distribution
8 engine locates a consumer box closest to the requesting consumer box that has the
9 requested data file. The distribution engine then sends information to the
10 requesting consumer box necessary to download the data file from the closest
11 consumer box. This information may include the address of the closest consumer
12 box, encryption data to decrypt the request data file, and other data. The
13 distribution engine may also request payment information from the requesting
14 consumer box and process payment (Specification 3:First ¶).

15 An understanding of the invention can be derived from a reading of exemplary
16 claim 1, which is reproduced below [bracketed matter and some paragraphing
17 added].

18 1. A method for implementation in an index server in a peer-to-peer
19 system, comprising:

20 [1] receiving, from a first peer, a request for a data file, the request
21 including an ID of the first peer;

22 [2] identifying a second peer having the data file from an index of
23 peers;

24 [3] processing payment for the data file; and

25 [4] sending, to the first peer,

26 [a] an address of the second peer and

27 [b] a first encryption dataset to decrypt the data file.

This appeal arises from the Examiner's Final Rejection, mailed January 10, 2005. The Appellant filed an Appeal Brief in support of the appeal on September 4, 2006. An Examiner's Answer to the Appeal Brief was mailed on November 30, 2006.

PRIOR ART

The Examiner relies upon the following prior art:

| | | |
|-------------|---|---------------|
| Cooper | US 2001/0051996 A1 | Dec. 13, 2001 |
| Hunter | US 2002/0111912 ¹ A1 | Aug. 15, 2002 |
| Jeff Tyson, | "How the Old Napster Worked," How Stuff Works | |

REJECTIONS²

Claims 1-4, 8, 10-19, 23, 25-35, 39-42, 44-49, 51, 53-60, 62, 64-71, 73, and 75-81 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Tyson and Cooper.³

Claims 5-7, 9, 20-22, 24, 36, 50, 52, 61, 63, 72, and 74 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Tyson, Cooper, and Hunter.

¹ The sole reference to this publication number in the Answer incorrectly refers to it as 2002/011912 (Answer 14). The correct citation is found on the List of References Cited of July 28, 2004. The claims subject to the rejection applying this reference are not separately argued by the Appellant.

² The Examiner also made a rejection under 35 U.S.C. § 101 (Final Rejection 3), but withdrew this rejection (Answer 18).

³ The Answer incorrectly includes claim 43 in this rejection (Answer 3). Claim 43 was cancelled in the amendment filed November 1, 2004.

ISSUES

The issues pertinent to this appeal are

- Whether the Appellant has sustained their burden of showing that the Examiner erred in rejecting claims 1-4, 8, 10-19, 23, 25-35, 39-42, 44-49, 51, 53-60, 62, 64-71, 73, and 75-81 under 35 U.S.C. § 103(a) as unpatentable over Tyson and Cooper.
- Whether the Appellant has sustained their burden of showing that the Examiner erred in rejecting claims 5-7, 9, 20-22, 24, 36, 50, 52, 61, 63, 72, and 74 under 35 U.S.C. § 103(a) as unpatentable over Tyson, Cooper, and Hunter.

The pertinent issue turns on whether the failure of Napster as a business due to a lack of a digital rights payment component negated the obviousness of the claimed subject matter.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are supported by a preponderance of the evidence.

Tyson

01. Tyson describes how in early 1999, Shawn Fanning began to develop a way to create a program that combined a search engine, file sharing, and internet relay chat (IRC) that would become the utility Napster. It quickly became one of the hottest downloads. Peer-to-Peer File Sharing Napster, or P2P, works such that when you want to download a song using Napster, you are downloading it from another person's machine,

1 and that person could be your next-door neighbor or someone halfway
2 around the world (Tyson 1).

3 02. The problem that the music industry had with Napster was that it was
4 a big, automated way to copy copyrighted material (Tyson 3).

5 03. Napster is now back in business as a legal, pay-per-song music-
6 download site (Tyson 1).

7 *Cooper*

8 04. Cooper is directed toward transaction module configured to initialize
9 a transaction with a user, authenticate the identity of a user, obtain a
10 digital certificate related to the user, search for content desired by the
11 user, implement a payment transaction with the user, generate a
12 watermark related to the user and transfer content to the user, and insert
13 said watermark into said content (Cooper ¶ 0018).

14 PRINCIPLES OF LAW

15 *Claim Construction*

16 During examination of a patent application, pending claims are given
17 their broadest reasonable construction consistent with the specification. *In*
18 *re Prater* , 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci.*
19 *Tech Ctr.*, 367 F.3d 1359, 1364, (Fed. Cir. 2004).

20 Limitations appearing in the specification but not recited in the claim are not
21 read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed.
22 Cir. 2003) (claims must be interpreted “in view of the specification” without
23 importing limitations from the specification into the claims unnecessarily).

Although a patent applicant is entitled to be his or her own lexicographer of patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such definitions in the Specification with sufficient clarity to provide a person of ordinary skill in the art with clear and precise notice of the meaning that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although an inventor is free to define the specific terms used to describe the invention, this must be done with reasonable clarity, deliberateness, and precision; where an inventor chooses to give terms uncommon meanings, the inventor must set out any uncommon definition in some manner within the patent disclosure so as to give one of ordinary skill in the art notice of the change).

Obviousness

A claimed invention is unpatentable if the differences between it and the prior art are “such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.” 35 U.S.C. § 103(a) (2000); *KSR Int’l v. Teleflex Inc.*, 127 S.Ct. 1727 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

In *Graham*, the Court held that that the obviousness analysis is bottomed on several basic factual inquiries: “[1] the scope and content of the prior art are to be determined; [2] differences between the prior art and the claims at issue are to be ascertained; and [3] the level of ordinary skill in the pertinent art resolved.” 383 U.S. at 17. *See also KSR Int’l v. Teleflex Inc.*, 127 S.Ct. at 1734. “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR*, at 1739.

“When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or in a

different one. If a person of ordinary skill in the art can implement a predictable variation, § 103 likely bars its patentability.” *Id.* at 1740.

“For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.” *Id.*

“Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.” *Id.* at 1742.

ANALYSIS

Claims 1-4, 8, 10-19, 23, 25-35, 39-42, 44-49, 51, 53-60, 62, 64-71, 73, and 75-81 rejected under 35 U.S.C. § 103(a) as unpatentable over Tyson and Cooper.

The Appellant argues these claims as a group.

Accordingly, we select claim 1 as representative of the group.
37 C.F.R. § 41.37(c)(1)(vii) (2006).

The Examiner found that Tyson described limitations [1], [2], and [4a] of claim 1 and Cooper described limitations [3] and [4b]. The Examiner implicitly found that one of ordinary skill knew of the use and importance of encryption in preventing unauthorized individuals from accessing digital content to reduce piracy. The Examiner concluded that it would have been obvious to a person of ordinary skill in the art to have applied Cooper to Tyson to so reduce piracy (Answer 3).

The Appellant does not dispute whether Tyson or Cooper describe the limitations as found by the Examiner. The Appellant contends that it would not

1 have been obvious to combine the references because no one has done so since the
2 failure of Napster due to a lack of a digital rights management component. The
3 Appellant argues that Napster ceased their P2P file sharing system because of
4 copyright violations and the inability to combine a P2P system with a digital rights
5 management system, and that the current version of Napster no longer enables the
6 transfer of files between peers. The Appellant characterizes Napster, as described
7 by Tyson, as a failed experiment and is therefore unavailable as prior art. For
8 support, the Appellant cites *Fromson v. Advance Offset Plate, Inc.*, 755 F.2d 1549,
9 1558 (Fed. Cir. 1985), citing *Picard v. United Aircraft Corp.*, 128 F.2d 632, 635
10 (2d Cir. 1942).

11 The Appellant's reliance on *Fromson* is misplaced. The failed experiment in
12 *Fromson* was in the prosecution history of a patent to Mason. Fromson, the patent
13 holder defending his patent, relied on Mason as a failed experiment to show
14 unexpected results, *id.* at 1554. The court, citing *Picard*, said that the failed
15 experiment rendered Mason's patent irrelevant as a prior art reference. The court
16 held *Fromson's* patent to be valid without relying on *Fromson's* argument
17 regarding Mason, and thus the court's discussion regarding Mason was dicta.
18 More to the point, in *Picard*, which is the source of the language the Appellants
19 point to, the failed experiment referred to an airplane engine that was known or
20 used prior to the date of invention. The court further stated that

21 the mere fact that an earlier "machine" or "manufacture,"
22 sold or used, was an experiment does not prevent its
23 becoming an anticipation or a part of the prior art,
24 provided it was perfected and thereafter became publicly
25 known. Whether it does become so depends upon how
26 far it becomes a part of the stock of knowledge of the art
27 in question.

1 *Picard* 128 F.2d at 635. If nothing else, Tyson shows that Napster was perfected
2 insofar as its technology and became publicly known. Whether it became a legal
3 or economic victim of its own success in the face of copyright law and consequent
4 law suits is irrelevant to the informative value of the technology employed in
5 Tyson and Napster to those of ordinary skill in the art.

6 The Appellant next argues that the failure of Napster teaches away from the
7 combination of Tyson and Cooper because Tyson says that "P2P is here to stay,
8 regardless of legality disputes." The Appellant argues that Tyson suggests there is
9 no solution to the legal issue of digital rights managements.

10 As the Federal Circuit held in *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994),
11 a reference may be said to teach away when a person of ordinary skill, upon
12 reading the reference, would be discouraged from following the path set out in the
13 reference, or would be led in a direction divergent from the path that was taken by
14 the applicant. As we found *supra*, far from discouraging one of ordinary skill,
15 Napster was successful. Napster's success would encourage further advance.
16 Napster failed as a business because of the ease of piracy (FF 02), not because
17 Napster was technically flawed. The quote that P2P is here to stay, far from
18 suggesting the absence of a solution to the legal issue, would instead suggest
19 solving the legal issue by paying for the content where payment is required, as
20 Napster does today (FF 03). Combining a payment mechanism with P2P is not
21 technically challenging, only expensive in terms of licensing content. In many
22 fields it may be that there is little discussion of obvious techniques or
23 combinations, and it often may be the case that market demand, rather than
24 scientific literature, will drive design trends. *KSR*, 127 S.Ct. at 1741. The fact that

1 market demand was for free content does not diminish the informative value of
2 either Napster as described by Tyson or Cooper to one of ordinary skill.

3 The Appellant has not sustained its burden of showing that the Examiner erred
4 in rejecting claims 1-4, 8, 10-19, 23, 25-35, 39-42, 44-49, 51, 53-60, 62, 64-71, 73,
5 and 75-81 under 35 U.S.C. § 103(a) as unpatentable over Tyson and Cooper.

6 *Claims 5-7, 9, 20-22, 24, 36, 50, 52, 61, 63, 72, and 74 rejected under 35 U.S.C. §*
7 *103(a) as unpatentable over Tyson, Cooper, and Hunter.*

8 The Appellant argued that these claims are patentable for the same reasons as
9 claim 1 (Br. 9), and therefore the Appellant has not sustained its burden of showing
10 that the Examiner erred in rejecting claims 5-7, 9, 20-22, 24, 36, 50, 52, 61, 63, 72,
11 and 74 under 35 U.S.C. § 103(a) as unpatentable over Tyson, Cooper, and Hunter.

12 CONCLUSIONS OF LAW

13 The Appellant has not sustained its burden of showing that the Examiner erred
14 in rejecting claims 1-42 and 44-81 under 35 U.S.C. § 103(a) as unpatentable over
15 the prior art.

16 On this record, the Appellant are not entitled to a patent containing claims 1-42
17 and 44-81.

18 DECISION

19 To summarize, our decision is as follows:

- 20 • The rejection of claims 1-4, 8, 10-19, 23, 25-35, 39-42, 44-49, 51, 53-60, 62,
21 64-71, 73, and 75-81 under 35 U.S.C. § 103(a) as unpatentable over Tyson
22 and Cooper is sustained.

- The rejection of claims 5-7, 9, 20-22, 24, 36, 50, 52, 61, 63, 72, and 74 under 35 U.S.C. § 103(a) as unpatentable over Tyson, Cooper, and Hunter is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

jlb

Squire, Sander & Dempsey L.L.P
Patent Department
One Maritime Plaza, Suite 300
San Francisco, CA 94111-3492